REMARKS

This is intended as a full and complete response to the Office Action dated October 28, 2005, having a shortened statutory period for response set to expire on January 28, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-46 are pending in the application. Claims 1-46 remain pending following entry of this response. Claims 1, 16, 27, 38, and 46 have been amended. The claims have been amended merely for clarification and not to overcome any rejection provided by the Examiner. Therefore, Applicants submit that the claims as amended are entitled to a full range of equivalents. Applicants submit that the amendments do not introduce new matter.

Claim Rejections - 35 U.S.C. § 103

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jong et al* (US 6,192,403, hereinafter *Jong*) in view of *Cline et al* (US 2002/0087897 AI, hereinafter *Cline*). Applicants respectfully traverse this rejection.

The Requirements of the Prima Facie Case of Obviousness

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *See* MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP § 2143. Applicants submit that the present rejection fails to establish at least the first and third requirements of the *prima facie* case of obviousness, as described below.

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The Cited References

In the Examiner's rejection under 35 U.S.C. Sec. 103(a), the Examiner cites *Jong* and *Cline*.

Jong describes a method and apparatus for adaptive system monitor and support system. *See Jong, Title*. The monitor monitors the monitored device based on a profile. *See Jong*, Col. 1, Lines 41-42. The profile identifies device functions that require special monitor and/or support programs. *See Jong*, Col. 1, Lines 42-43. The special monitor and/or support programs are downloaded from an adaptive monitor and support device located remotely relative to the monitored devices. *See Jong*, Col. 1, Lines 42-46.

Cline is directed to dynamically changing the performance of devices in a computer platform. *See Cline, Title*. *Cline* describes a device controller that can have multiple device performance states which represent different levels of performance vs. power consumption during operation. *See Cline, Abstract*. The controller may have a processor performance state status register which can be used to affect the desired choice of a device performance state based on the performance state of the processor. *See Cline, Abstract*. The device performance state of multiple devices can be coordinated to achieve an improved system-level reduction in power consumption, while maintaining sufficient operation capability. *See Cline, Abstract*.

1. The First Requirement of the Prima Facie Case of Obviousness

With respect to the required motivation to combine the references, the Examiner states that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system solution based on the usage trend as taught by *Cline* into the system of *Jong* because it would provide such comprehensive control over operational states of a computer system." *See Office Action dated October 28, 2005* (hereinafter *Office Action*), Pg. 3, Para. 2. Thus, the Examiner has cited the "usage trend" described in *Cline* as an alleged benefit in providing comprehensive

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control over operational states of a computer system. *Id.* However, selecting the operational states of a computer system is described as an aspect of *Cline*, not of *Jong*. *See Cline, Abstract; compare Jong, Abstract*. Thus, the Examiner has cited an alleged benefit taught by *Cline* as a basis for improving an aspect of *Cline*, namely, selecting an operational state of a computer system. *See Cline, Abstract*. Therefore, the Examiner's stated motivation to combine merely describes aspects of *Cline*, and does not describe a motivation to combine aspects of *Cline* with aspects of *Jong*. Accordingly, the Examiner has not satisfied the first requirement of the *prima facie* case of obviousness by providing a motivation to combine the cited references. Withdrawal of the rejection is respectfully requested.

Further, the fact the something <u>can</u> be combined does not make it obvious to do so. MPEP § 2143.01. Here, *Cline* and *Jong* are directed to unrelated functions. As a result, assuming *Cline* and *Jong* can be combined, the combination results in nothing more than an integrated system capable of performing the unrelated aspects of *Cline* and *Jong*. The combination does not result in an enhancement to the operations taught by *Jong*, and vice versa, the combination does not result in an enhancement to the operations taught by *Cline*. Thus, the combination is arbitrary. Accordingly, the rejection is believed to be improper and Applicants respectfully request that the rejection be withdrawn.

2. The Third Requirement of the Prima Facie Case of Obviousness

Applicants' respectfully submit that the cited references do not teach all claim limitations. For example, the pending claims describe "generating a recommendation, comprising at least one computer system solution, which satisfies at least the projected requirements". The Examiner states that *Jong* discloses "generating a recommendation, comprising at least one computer system solution, which satisfies at least the projected requirements" at Col. 12, Line 63 to Col. 13, Line 7. *See Office Action*, Pg. 2, Para. 4. However, the cited section is only directed to allowing subscribers to a service to request monitoring of various product usages. *See Jong*, Col. 12, Line 63 to Col. 13, Line 7. A database may be accessed to determine whether

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special monitoring and support is required. *See id.* Thus, the cited section described monitoring product usages, and does not describe generating a recommendation. Indeed, neither *Jong* nor *Cline* contain the term "recommendation". Accordingly, the cited references, alone or in combination do not describe "generating a recommendation, comprising at least one computer system solution, which satisfies at least the projected requirements". Withdrawal of the rejection is respectfully requested.

The cited section also fails to describe "generating a recommendation, comprising at least one computer system solution, which satisfies at least the projected requirements" because the cited section does not describe at least one computer system solution which satisfies projected requirements. *See Jong,* Col. 12, Line 63 to Col. 13, Line 7. As described above, the cited section merely describes monitoring product usages and retrieving information from a database. *See id.* With respect to *Cline, Cline* merely describes changing the performance of devices in a computer platform. *See Cline, Abstract.* Accordingly, the cited references, alone or in combination, do not describe a recommendation, comprising at least one computer system solution, which satisfies projected requirements, and thus do not describe "generating a recommendation, comprising at least one computer system solution, which satisfies at least the projected requirements". Withdrawal of the rejection is respectfully requested.

With respect to the dependent claims, the Examiner has not provided reasons as to why the dependent claims have been rejected. For example, the Examiner has not identified a portion of the cited references which describes the subject matter of at least dependent claims 4, 5, and 6. Furthermore, with respect to other dependent claims, the Examiner has not been specific enough to apprise the Applicants of the basis for rejection. For example, the Examiner states that "*Jong's* system performance can be collected a[t] intervals shorter than the first time intervals as claimed" without providing either a claim number being rejected or a citation to any portion of *Jong* which teaches the stated subject matter. The Examiner is required to give a basis for rejecting <u>each</u>

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claim. In the absence of a rejection, Applicants presume the claims are allowable. Accordingly, withdrawal of the rejection is respectfully requested.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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